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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,356	10/21/2003	Fumitaka Ueda	Q77836	4209
23373 7590 02/23/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER VISCONTI, GERALDINA	
			ART UNIT 1752	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/689,356

Applicant(s)

UEDA ET AL.

Examiner

Geraldina Visconti

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1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

GERALDINA VISCONTI
PRIMARY EXAMINER

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This office action is responsive to the Amendment filed December 6, 2006. Claim 1 has been canceled. Claims 2-17 are pending and presently under consideration in this application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

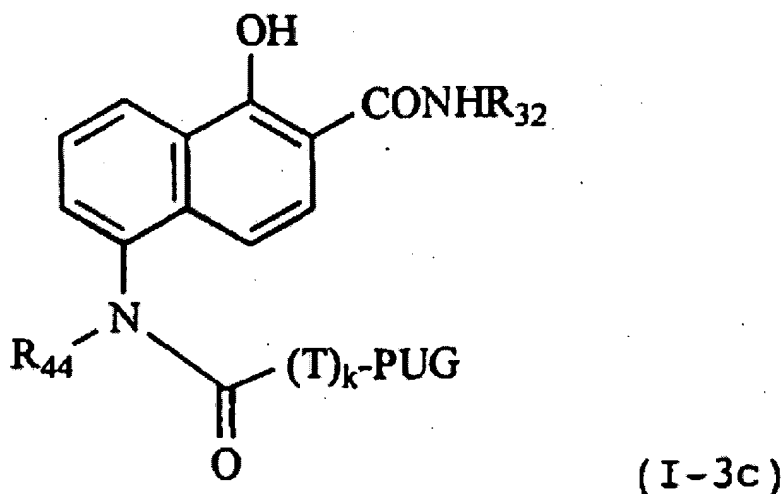
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (European Patent No. EP950922A1) in view of Kondo (U.S. Patent No. 6,080,535).

Ito et al. discloses a silver halide color photographic material having improved sharpness and color reproducibility, said material containing a coupler capable of releasing a photographically useful group or its precursor by a coupling reaction between the coupler and a developing agent in an oxidized form, wherein the coupler releases the photographically useful group or its precursor by an intramolecular nucleophilic substitution reaction using the nitrogen atom that directly bonds to a coupling position of a product obtained by the coupling reaction and that originates from the developing agent. Known silver halide emulsions are generally disclosed on pages 65-66, with no particular preference noted therein.

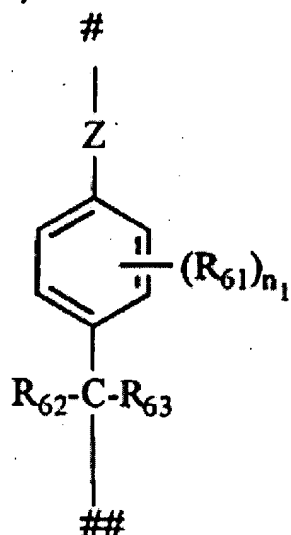
Responsive to applicants' arguments that the couplers of the instant formulae (I) and (II) as defined in the base independent claim, now 17, specifically with its recitation of the groups for the substituent R_3 , are distinguished from the compounds of the prior art of record, namely Ito et al., the Examiner notes the following:

The coupler of the general formula (I-3c) disclosed on page 6 is inclusive of the basic structure of the couplers of the instant formulae (I) and (II).

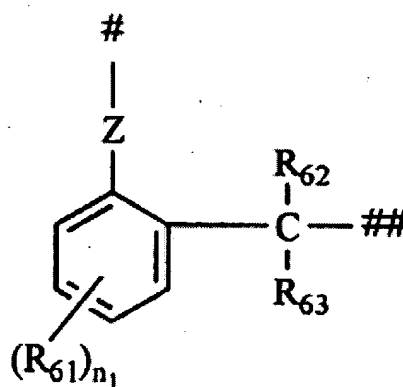
EP 0 950 922 A1

When the timing groups are (T3) and (T2), as defined on page 14 therein, the compounds represented by formula (I-3c) are further respectively inclusive of the instant formulae (I) and (II).

(T3)



(T2)



Please note that the substituents R_{62} and R_{63} are respectively inclusive of the instant substituents R_4 and R_5 . Similarly, the substituent R_{61} is respectively inclusive of the instant substituent R_3 . Refer to [0047].

Kondo discloses a silver halide emulsion having enhanced sensitivity without increasing fog, said emulsion comprising tabular silver halide grains wherein at least 50% of the total grain projected area is accounted for by grains having an aspect ratio greater than 5 and containing silver iodide, wherein the grains meet the relationship recited in the instant claims 5-8.

It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to incorporate the silver halide emulsion taught in Kondo into at least one silver halide emulsion layer of the photographic material of Ito et al., with reasonable expectations of achieving, absent object evidence to the contrary, the advantages taught therein as well as those achieved with the use of the emulsion.

Response to Arguments

3. *For The Examiner is of the opinion that applicants' cancellation of claim 1 and amendment thereby making claim 17 the base independent claim is insufficient to distinguish the instant claims from the prior art of record. Therefore the Examiner's previous remarks regarding applicants' arguments still apply. For convenience, these remarks are reproduced as follows.*

The Applicants concede that Ito et al. teaches a compound entirely within the scope of the instant claims, but then state that said compound was only incidentally included therein. Applicants refer to experimental data herein the specification as evidence of the unexpected results achieved with the instant invention. The invention presently claimed is drawn to a silver halide photosensitive material generally characterized by containing the combination of (a) at least one compound represented by the general formula (I) or general formula (II), and (b) at least one light-sensitive layer comprising a silver halide emulsion containing silver halide grains, each having an aspect ratio of 5 or more accounting for 60% or more of the total projected area of silver halide grains. Applicants refer to Table 3 herein the specification as evidence of the unexpected photographic advantages, particularly with respect to speed, sharpness and graininess, achieved with the combination of (a) and (b). Upon consideration of said experimental data, the Examiner notes that there is insufficient evidence of record to undeniably illustrate unexpected results achieved with the claimed combination.

With respect to Sample Nos. 101-104: Compounds (31), (44) and (54), respectively inclusive of the instant formulae (I), (II) and (II), were respectively utilized in

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comparative samples 102, 103 and 104. While all of the samples 101-104 contain the same emulsions, none of the samples 101-104 contain the claimed silver halide emulsion. Thus, the only variable between samples 101 and 102-104 is the compound. As suspected, use of a compound inclusive of formula (I) or (II) results in a marked increase in the interlayer effect. There are no corresponding inventive samples containing compounds (31), (44) and (54) with the claimed silver halide emulsion, enabling the proper evaluation of the impact of utilizing the claimed silver halide emulsion.

With respect to Sample Nos. 105-108: Compounds (24), (32) and (37), inclusive of the instant formula (I), were respectively utilized in samples 106, 107 and 108. All of the samples 105-108 contain the same emulsions, which are the claimed silver halide emulsion. Again, the only variable between samples 105 and 106-108 is the compound. As suspected, use of a compound inclusive of formula (I) or (II) results in a marked increase in the interlayer effect. There are no corresponding comparative samples containing compounds (24), (32) and (37) without the claimed silver halide emulsion, enabling the proper evaluation of the impact of utilizing the claimed silver halide emulsion.

With respect to Sample Nos. 109-114: Compounds (24), (32), (37), (57) and (61) inclusive of the instant formula (I), were respectively utilized in samples 110, 111, 112, 113 and 114. All of the samples 109-114 contain the same emulsions, which are the claimed silver halide emulsion. Again, the only variable between samples 109 and 110-114 is the compound. As suspected, use of a compound inclusive of formula (I) or (II)

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results in a marked increase in the interlayer effect. There are no corresponding comparative samples containing compounds (24), (32), (37), (57) and (61) without the claimed silver halide emulsion, enabling the proper evaluation of the impact of utilizing the claimed silver halide emulsion.

Also, with respect to samples 101-114, it appears as if the silver halide grains in the emulsions utilized therein meet the further limitation of satisfying the relationship: $I_2/I_1 < 1$, which would mean that the experimental results herein the specification are commensurate in scope only with claims 5-8.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldina Visconti whose telephone number is (571) 272-1334. The examiner can normally be reached 8:00am to 4:30pm.


GERALDINA VISCONTI
PRIMARY EXAMINER

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.